

R E M A R K S

1. Claims 1-15 are pending in this Application. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the discussion that follows.

The drawings have been objected to. Claims 1-15 have been rejected under 35 U.S.C. §112, first paragraph, as being nonenabling. Claim 1 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,755,052 to Keeney. After a careful review of the claims, it has been concluded that the rejections of the claims are improper and the rejections are, therefore, traversed.

2. The drawings have been objected to. In particular, the Examiner asserts that "the spring disposed completely outside the internal chamber must be shown or the feature(s) canceled from the claim(s)" (Office Action of 3/30/05, page 2). In response, a proposed FIG. 2C is included as an accommodation to the Examiner that shows a top cut-away view of FIG. 2B with the spring disposed completely outside the internal chamber. No new matter has been added.

The Examiner also asserts that FIGs. 6a-7b have identical reference numbers. In response, proposed marked-up

FIGs. 7A-8B and 9 are enclosed. In the specification, paragraphs [0040] to [0042] have been revised accordingly.

3. Claims 1-15 have been rejected under 35 U.S.C. §112, first paragraph, as being nonenabling. In particular, the Examiner asserts that "the specification . . . does not reasonably provide enablement for how the spring is disposed outside the internal chamber" (Office Action of 3/30/05, page 3). However, the specification clearly describes an internal chamber 32 and slide enclosure 24 where the internal chamber 32 is completely separated from the slide enclosure 24 (and spring 20) by a slot 34 (par. [0024]). FIGs. 2A-B clearly shows the relationship of the spring 20 as being completely outside the internal chamber 32. FIG. 2C merely provides an additional view of the relationships shown in FIGs. 2A-B.

The Examiner asserts that "The specification and figures show that a secondary spring engagement portion 300 shown in figures 7a and 7b lies inside the internal chamber 32, which is shown as the interior of the clip 10 (note there is no drawings showing how these elements fit in relation to each other)" (Office Action of 3/30/05, page 3). In response, the outline of the clip 10 has been shown in phantom lines in FIG. 7B. In this regard, the phantom lines of proposed FIG. 7B merely

show what paragraph [0035] of the specification clearly sets forth.

The Examiner asserts that "The springs 200, 212, 106 (figure 8) and 18 are all shown within the interior of clip 10 or otherwise in the internal chamber 32" (Office Action of 3/30/05, page 3). However, the specification clearly states (par. [0035]) that the spring engagement portions 302 lie outside the internal chamber 32. Since the springs 200, 202 engage the spring engagement portion 302 in a spring channel 210, the springs 200, 202 are clearly outside the internal chamber 32. In addition, paragraph [0024] also clearly establishes that the first end 106 of the slide 22 is disposed in the slide enclosure 24, which is again outside the internal chamber.

The Examiner asserts that "the spring 20, disclosed in the application, is not shown in the figures" (Office Action of 3/30/05, page 3). However the spring 20 is clearly shown in FIG. 2B.

It is noted next that "a specification disclosure which contains a teaching of the manner and process of making an using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of §112 unless there is reason to doubt the object truth of the statements contained therein which must be

relied upon for enabling support" (In re Marzocci & Horton, 169 USPQ 367, 369 (CCPA, 1971). In this regard, the subject matter sought to be patented is defined in claim 1 as being "a spring . . . disposed completely outside the internal chamber". FIGs. 2A-B, 3A-B and 4A-B clearly show and paragraph [0035] describes the spring(s) 20, 200, 202 as being disposed completely outside the internal chamber.

If the Examiner disagrees that the spring is disposed completely outside the internal chamber, then "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in the supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement" (In re Marzocci & Horton, 169 USPQ 367, 370 (CCPA, 1971). This the Examiner has not done. Since the Examiner has failed to provide any basis for doubting the objective truth of any part of the specification, the rejections are improper and should be withdrawn.

4. Claim 1 has been rejected as being anticipated by Keeney. However, a review of Keeney clearly shows (Keeney FIGs. 14, 15, 16, 17, 22, 23, 24) that the spring is disposed completely inside the internal chamber. If the Examiner believes that the prior art shows "a spring that urges the moveable

carriage towards the loading end, said spring being disposed completely outside the internal chamber", then the Examiner is respectfully requested to provide a reference that establishes such fact as required by 37 C.F.R. §1.104(d)(1). If the Examiner is relying upon her own personal knowledge, then the Examiner is requested to provide an affidavit establishing such facts as required by 37 C.F.R. §1.104(d)(2).

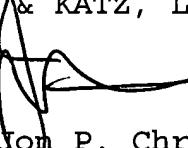
Since the Keeney spring is disposed within the internal chamber, Keeney does not do the same or any similar thing as that of the claimed invention. Since Keeney does not do the same or any similar thing as that of the claimed invention, the rejection is improper and should be withdrawn.

5. The allowance of claims 1-15 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

WELSH & KATZ, LTD.

By


Jon P. Christensen
Registration No. 34,137

September 22, 2005
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500